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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MATTHIAS SCHOLL 14781 MEMORIAL DRIVE SUITE 1319 HOUSTON, TX 77079				
EXAMINER				
MACKEY, JAMES P				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/598,507

Applicant(s)

NIES ET AL.

Examiner

James Mackey

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Objections

Claim 1 is objected to because of the following informalities: on line 4 of claim 1, "steal" should be --steel--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as **failing to comply with the written description requirement**. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not adequately describe the claimed clamping plate because the original disclosure does not describe a "heat-insulating thermosetting core" (claim 1, line 2); does not adequately describe any process, including "gluing and pressing events" (claim 1, line 4), of gluing the "sandwich-like structure" of the claimed clamping plate, neither an SMC process nor another process "distinguished therefrom" (claim 1, lines 7-8); and does not adequately describe an irreversible bond between the core and steel covers (claim 1, line 10). The only disclosure reciting the particulars of

the inventive clamping plate is provided in the single paragraph [0005], reproduced hereinbelow in its entirety:

“[0005] This requirement is fulfilled in embodiments of the invention in that the clamping plate is provided as a multilayer composite panel having thermally-insulating steel components (2) and tool steel components (1) and (3), while the exterior sides are always made of tool steel.”

This minimal description does not provide descriptive support for the invention as claimed.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as **based on a disclosure which is not enabling**. The “special gluing process” (claim 1, line 3) and “the resin formulation” (claim 1, line 8) are claimed as being critical or essential to the practice of the invention, but neither is enabled by the disclosure, which does not include **any** description of the process of manufacturing the claimed clamping plate nor of the resin formulation of the molding compound which forms the heat-insulating core of the claimed clamping plate. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 2-3, "on exterior surfaces" is indefinite as to which structure includes the exterior surfaces; line 3, "their joint" lacks proper antecedent basis in the claim; line 3, "special gluing process" is of indefinite scope since it is unclear as to exactly what is intended by "special"; line 5, "preferably" renders the claim indefinite because it is unclear whether the limitation following the phrase is part of the claimed invention (see MPEP § 2173.05(d)); lines 7-8 are indefinite as to the particulars of the recited process, how the process "is related to an SMC process", and how the process "is distinguished therefrom"; and line 8, "the resin formulation" lacks proper antecedent basis in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by any one of German Patent Document 2,021,732 (Figure 1); Japanese Patent Document 58-12716 (Figure 1) and Japanese Patent Document 63-91216 (Figure 1).

Each of German '732, Japan '716 and Japan '216 teaches a clamping plate comprising a sandwich structure of two outer steel plates (elements 1, 2 in German '732; elements 5a, 5c, 8a, 8c, 13a, 13c in Japan '716; elements 12b, 32b in Japan '216) with a central heat-insulating thermosetting resin core (element 3 in German '732; elements 5b, 8b, 13b in Japan '716; elements 12a, 32a in Japan '216). With regard to the claim recitations regarding the method of forming the claimed apparatus, such relate only to the method of producing the claimed apparatus, which does not impart patentability to the apparatus claim. Note that determination of patentability is based on the product apparatus itself, *In re Brown*, 173 USPQ 685, 688, and the patentability of a product does not depend on its method of production, *In re Pilkington*, 162 USPQ 145, 147; see also *In re Thorpe*, 227 USPQ 964. Note also that it is Applicants' burden to prove that an unobvious difference exists, *In re Marosi*, 218 USPQ 289, 292-293, and Applicant must show that different methods of manufacture produce articles having inherently different characteristics, *Ex parte Skinner*, 2 USPQ2d 1788. See MPEP § 2113.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ceraso (U.S. Patent 5,804,013; col. 3, lines 55-58) teaches a

clamping plate having lower and upper clamping plates 25-27 and 28-30 each comprising a sandwich structure of outer metal plates and an inner insulating core.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Mackey/
Primary Examiner
Art Unit 1791

jpm
February 13, 2009